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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/804,745

03/13/2001

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M19-106

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EXAMINER

FISHER, ABIGAIL L

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/804,745	<b>Applicant(s)</b> COHN ET AL.	
	<b>Examiner</b> ABIGAIL FISHER	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 7 and 89-102 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-7 and 89-102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt of Amendments/Remarks filed on October 13 2009 is acknowledged.  
Claims 4-5 and 8-88 were/stand cancelled. Claims 1-3, 6-7 and 89-102 are pending.

### ***Response to Arguments***

Applicant's arguments, see page 3 (second paragraph), filed October 13 2009, with respect to the rejection(s) of claim(s) **1-3, 6-7 and 89-102** under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Nair et al. (US Patent No. 5429826).

### ***Claim Interpretation***

Claim 1 and the claims that depend from claim 1 contain the transitional language "consisting essentially of". For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *PPG Industries Inc. V Guardian Industries Corp.* 48 USPQ2d 1351 (Fed. Cir.

1998) and *In re De Lajarte* 337 F.2d 870, 143 USPQ 256 (CCPA 1964) **See MPEP 2111.03.**

The instant specification does not define the term “consisting essentially of” in a manner that would allow one skilled in the art to determine what basic and novel characteristics are being materially affected.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3, 7 and 89-91 are rejected under 35 U.S.C. 102(b) as being anticipated by Nair et al.**

Nair exemplify a the  $\alpha$  -Methyl-poly(ethylene oxide-b-caprolactone) block copolymer. One block is  $\alpha$ -Methyl-poly(ethylene oxide). This reads on the non-reactive group being methyl ( $C_1$ ) and the polyoxyalkylene polymer is a polyethyleneoxide polymer. The other block is derived from monomers of caprolactone (column 5, I., lines 5-29). There are three crosslinking methods taught. Crosslinking method B utilizes the inclusion of 1 to 5% by weight of the polymer of a polyfunctional crosslinker. Table I exemplifies the crosslinking of the  $\alpha$  -Methyl-poly(ethylene oxide-b-caprolactone) polymer via crosslinking Method B (examples 9 and 10).

Therefore, Nair et al. teach AB block copolymers wherein one block is caprolactone and the other is polyethyleneoxide which is endcapped with a methyl group and the diblock is further reacted with a crosslinking agent to produce crosslinked diblocks.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 6 and 92-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nair.**

### **Applicant Claims**

The instant application claims the A portion of the AB block is derived from the polymerization of lactide monomers.

### **Determination of the Scope and Content of the Prior Art (MPEP §2141.01)**

Nair exemplify a block copolymer wherein one block is  $\alpha$ -Methyl-poly(ethylene oxide). This reads on the non-reactive group being methyl ( $C_1$ ) and the polyoxyalkylene polymer is a polyethyleneoxide polymer. The other block is derived from monomers of caprolactone (column 5, I., lines 5-29). There are three crosslinking methods taught. Crosslinking method B utilizes the inclusion of 1 to 5% by weight of the polymer of a polyfunctional crosslinker. Table I exemplifies the crosslinking of the  $\alpha$ -Methyl-poly(ethylene oxide-b-caprolactone) polymer via crosslinking Method B (examples 9 and 10).

It is generally taught that the more particularly preferred polyester includes polycaprolactone and polylactic acid (column 3, lines 4-8).

### **Ascertainment of the Difference Between Scope the Prior Art and the Claims (MPEP §2141.012)**

While Nair et al. teach that polylactic acid are suitable polyesters to utilize, Nair et al. do not exemplify the formation of polymers comprising polylactic acid.

***Finding of Prima Facie Obviousness Rational and Motivation  
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize polylactic acid in combination with methyl capped polyethylene oxide. It would have been obvious to one of ordinary skill in the art to try any of the specifically taught polyesters as a person with ordinary skill has good reason to pursue known options within his or her technical grasp. **Note: MPEP 2141 [R-6] KSR International CO. v. Teleflex Inc.** 82 USPQ 2d 1385 (Supreme Court 2007). Furthermore, it would have been obvious to one of ordinary skill in the art to replace the exemplified caprolactone with lactic acid as both are taught by Nair et al. as being particularly preferred polyester to utilize in the formation of the polymers.

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABIGAIL FISHER whose telephone number is (571)270-3502. The examiner can normally be reached on M-Th 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abigail Fisher  
Examiner  
Art Unit 1616

/Johann R. Richter/  
Supervisory Patent Examiner, Art Unit 1616